

## **REMARKS / ARGUMENTS**

### ***Remaining Claims***

Twenty Five (25) claims (Claims 1 – 25) remain pending in this application through this Amendment. Claims 26 – 35 have been withdrawn from further consideration. The specification has been amended to fix obvious typographical errors. No new matter is added.

### ***Objection to Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference signs for tabs -55-; protrusions -57-; tabs -59-; and sprue -134-. Corrected figures 3 and 10C are attached hereto. Accordingly, Applicants respectfully request that this objection be withdrawn.

### ***Objection to Disclosure***

The disclosure is objected to because it contains symbols that are unclear as to the intention. Applicants thank the Examiner for his helpful clarification in the locations of these symbols and have amended the specification by replacing the offending symbol with a " (quotation mark). Accordingly, Applicants respectfully request that this objection be withdrawn.

### ***Rejection of Claims 1 - 4, 13 - 15, 17 - 18, and 23 - 24 under 35 USC §103(a) - Kretzchmar, et al. in view of Portney, et al. and Buazza, et al.***

Claims 1 - 4, 13 - 15, 17 - 18, and 23 - 24 stand rejected under 35 USC §103(a) as being obvious under US Patent No. 5,782,460 to *Kretzchmar, et al.* in view of US Patent No. 5,053,171 to *Portney, et al.* and US Patent No. 5,989,462 to *Buazza, et al.*

Examiner is correct in stating that *Kretzchmar* teaches a mask on the surface of a mold that blocks UV curing light and that *Portney* and *Buazza* teach hazy filters through which light is passed *on its way to the mold*. However, *Portney* does not teach "the manufacture of ophthalmic lenses wherein the UV curing light (30) is prevented from reaching areas of the molding surface" (Off. Act. p. 5). *Portney* teaches a hazy filter to allow varying intensities of an "excimer laser" to reach and ablate a preformed work piece. (Col. 3, line 62 – 65) This is entirely different that the claimed "curing light" and the opposite effect is achieved by selectively blocking and transmitting light.

Furthermore, while the mask of *Kretzchmar* is a metallic mask (Col. 11, lines 22 – 25) that is arranged at the surface of a mold (Col. 11, lines 35 – 38), the present invention claims a "co-molded" material that is an integral part of the mold.

Even though the remaining two references do teach thermoplastic filters, they differ from the present invention to even a greater extent. As explained above, *Portney* does not even include a mold, as the described process cuts a work piece with an excimer laser. In any event, the filter is merely placed between laser and the work piece (Col. 3, lines 65 – 66) and certainly not co-molded with a “first section that includes an optical surface” as is required by the claims.

Likewise, *Buazza*, does not teach a filter that is an integral part of the mold, but merely places the filter “between an ultraviolet light source and the mold member” (Col. 73, lines 6 – 8). Once again, *Buazza* does not teach a mask co-molded with a “first section that includes an optical surface” as is required by the claims. In fact, *Buazza* does not teach a first UV-transparent section and second UV-opaque section at all, but merely disperses a hazing compound (e.g. bisphenol – which is not a thermoplastic and is not polymerizable) uniformly within a thermoplastic to form a filter. Any light attenuation by this hazy filter is not the result of differential concentrations of bisphenol in selected areas of the filter (which, in any event, is not taught nor suggested by *Buazza*), but is rather, explicitly thought to be merely proportional to the thickness of the filter. (Col. 73, lines 38 – 40)

No combination of these references would motivate one of ordinary skill in the art to co-mold a first section that transmits light and having an optical surface with a second section disposed radially outward from the optical surface.

Therefore, since the cited combination of prior art does not fairly teach or suggest the claimed invention, Claims 1 - 4, 13 - 15, 17 - 18, and 23 - 24 are not rendered obvious by *Kretzchmar, et al.* in view of *Portney, et al.* and *Buazza, et al.* Applicants, therefore, respectfully request that this rejection be withdrawn.

***Rejection of Claims 5 - 6, 9 - 11, 16, and 20 - 21 under 35 USC §103(a) - Kretzchmar, et al. in view of Portney, et al.; Buazza, et al.; and Doke, et al.***

Claims 5 – 6, 9 - 11, 16, and 20 – 21 stand rejected under 35 USC §103(a) as being obvious under US Patent No. 5,782,460 to *Kretzchmar, et al.* in view of US Patent No. 5,053,171 to *Portney, et al.*; US Patent No. 5,989,462 to *Buazza, et al.*; and US Patent No. 6,071,111 to *Doke, et al.*

*Kretzchmar, et al.* in view of *Portney, et al.* and *Buazza, et al.* has been discussed above. *Doke, et al.* does not provide any further teachings or suggestions that would render the claimed invention obvious.

Therefore, since the cited combination of prior art does not fairly teach or suggest the claimed invention, Claims 5 - 6, 9 - 11, 16, and 20 - 21 are not rendered obvious by *Kretzchmar, et al.* in view of *Portney, et al.*; *Buazza, et al.*; and *Doke, et al.* Applicants, therefore, respectfully request that this rejection be withdrawn.

***Rejection of Claims 7 -8, 19, and 25 under 35 USC §103(a) - Kretzchmar, et al. in view of Portney, et al.; Buazza, et al.; Doke, et al.; and Friske***

Claims 7 -8, 19, and 25 stand rejected under 35 USC §103(a) as being obvious under US Patent No. 5,782,460 to *Kretzchmar, et al.* in view of US Patent No. 5,053,171 to *Portney, et al.* and US Patent No. 5,989,462 to *Buazza, et al.*; US Patent No. 6,071,111 to *Doke, et al.*; and US Patent No. 5,254,000 to *Friske*.

*Kretzchmar, et al.* in view of *Portney, et al.* and *Buazza, et al.* has been discussed above. Neither *Doke, et al.* nor *Friske* provide any further teachings or suggestions that would render the claimed invention obvious.

Therefore, since the cited combination of prior art does not fairly teach or suggest the claimed invention, Claims 7 -8, 19, and 25 are not rendered obvious by *Kretzchmar, et al.* in view of *Portney, et al.*; *Buazza, et al.*; *Doke, et al.*; and *Friske*. Applicants, therefore, respectfully request that this rejection be withdrawn.

***Rejection of Claims 12 and 22 under 35 USC §103(a) - Kretzchmar, et al. in view of Portney, et al.; Buazza, et al.; Doke, et al.; and Fogarty***

Claims 12 and 22 stand rejected under 35 USC §103(a) as being obvious under US Patent No. 5,782,460 to *Kretzchmar, et al.* in view of US Patent No. 5,053,171 to *Portney, et al.* and US Patent No. 5,989,462 to *Buazza, et al.*; US Patent No. 6,071,111 to *Doke, et al.*; and US Patent No. 5,160,749 to *Fogarty*.

*Kretzchmar, et al.* in view of *Portney, et al.* and *Buazza, et al.* has been discussed above. Neither *Doke, et al.* nor *Fogarty* provide any further teachings or suggestions that would render the claimed invention obvious.

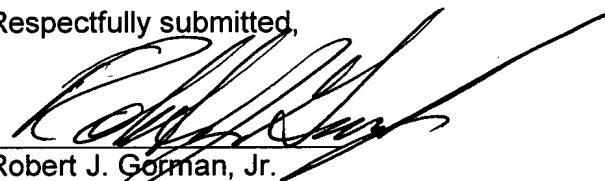
Therefore, since the cited combination of prior art does not fairly teach or suggest the claimed invention, Claims 12 and 22 are not rendered obvious by *Kretzchmar, et al.* in view of *Portney, et al.*; *Buazza, et al.*; *Doke, et al.*; and *Fogarty*. Applicants, therefore, respectfully request that this rejection be withdrawn.

**CONCLUSION**

In view of the foregoing and in conclusion, Applicants submit that the 35 USC §103 rejection(s) set-forth in the Office Action have been overcome, and that the pending claims are not obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action. Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned.

Please address all correspondence to Novartis Corporation, Corporate Intellectual Property, One Health Plaza, Bldg. 430, East Hanover, NJ 07936-1080. The commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §1.16 and 1.17, or credit any overpayment, to Deposit Account No. 19-0134.

Respectfully submitted,



Robert J. Gorman, Jr.  
Reg. No. 41,789  
(678) 415.4389

Novartis Corporation  
Corporate Intellectual Property  
One Health Plaza, Bldg. 430  
East Hanover, NJ 07936-1080

s:\jc legal department\public\patents\prosecut\2116\la\amendment b.doc